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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,914	11/26/2001	Douglas James Little	08613.0002	7544
22852 7590 08/20/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER TRAN, HAI	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 08/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/991,914

Applicant(s)

LITTLE ET AL.

Examiner

Hai Tran

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3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 28-41, 54, 66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 42-53, 55-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/18/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the communication in response to the Amendment filed by the applicant on June 15, 2007, titled: "Methods And Apparatus For Developing Investments".
2. Applicant has elected Group I, claims 1-27, 42-53, and 55-65 for prosecution without traverse. Group II, claims 28-41, 54, 63, and Group III, claim 66 have been cancelled and withdrawn from prosecution. Since claim 63 applies to Groups I and II, Examiner has examined it with Group I.
3. Claims 1-27, 42-53, and 55-65 are pending in this application and have been examined.

Priority

4. This application claims the benefit of a foreign application Australia 78277/01, filed October 8, 2001.

Abstract Objection

5. The abstract is objected to because it has more than 200 words. An abstract should be a brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. An abstract is a concise statement of the technical disclosure of the patent application and should include that which is new in the art to which the invention pertains. (See MPEP § 608.01(b)). It is important that the abstract not exceed 150 words in length since the

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space provided for the abstract on the computer tape used by the printer is limited.

Appropriate correction is required.

Specification Objection

6. The specification is objected because of the following informalities: There are errors and typos in the specification, and the following are a few examples.
7. The phrase "and the like" in the last paragraph on page 12 renders the specification to be indefinite as it is not properly defined. (See MPEP § 2173.05(d)).
8. The term "whilst" on page 17, line 18 is misspelled.
9. Applicant is required to find all errors and correct them as appropriately.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 2, 5, 23, 24, 25, 44, 52, 53 and 64 are rejected under U.S.C. 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention. More specifically,

12. The term "substantially" used in these claims is a relative term, which renders the claims to be indefinite. The term is not properly defined, and the specification does not provide a standard for ascertaining the requisite degree and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

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13. Claims 58-63 are rejected under 35 U.S.C. 112, fourth paragraph, as being in improper dependent form for failing to further limit the subject matter of their independent claims.

14. MPEP § 608.01(n) III describes the test to determine whether a claim is a proper dependent. Specifically, a dependent claim must include every limitation of the claim from which it depends. In the instance, independent claim 1 recites a method of determining a weighting of an investment portfolio, dependent claim 58 recites an investment portfolio weighting determined by the independent method claim 1 or apparatus claim 44. This is improper as it could infringe the dependent claim without infringing the base independent claim.

15. In addition, claims 58-63 appear to be a statement and do not have any steps or elements for performing any action. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

16. Claims 2 and 24 are rejected under 35 U.S.C. 112, fourth paragraph, as being in improper dependent form for failing to further limit the subject matter of their independent claims 1 and 23 respectively. Specifically,

17. The limitation of claims 2 and 24 "having a weighting substantially equal to said required industry weighting" does not further limit the subject matter of their independent claims "weighting equals or exceeds said required industry weighting". The term substantially is not properly defined in the specification. Applicant is required to cancel

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the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. (MPEP § 608.01(n)).

18. Appropriate correction is required.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1-27, 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Yip (U.S. Patent Application Publication No. 2003/0065602) ("Yip").

21. **Regarding claim 1**, Yip teaches a method for determining a weighting of an investment portfolio selected from a range of domestic and international financial investments, said method comprising the steps of:

a) dividing said range of domestic and international financial investments into a plurality of industry based groups (see Table I, paragraph 78);

b) selecting one of said industry based groups (see Table I, paragraph 78);

c) determining a required industry weighting for said selected industry based group (see Table II, 3rd column, "Annualized World Return", paragraph 81);

d) determining an available domestic weighting for said selected industry based group (see Table II, 2nd column, "EW Cluster Return", paragraph 81);

e) determining a mixture of financial investments within said selected industry based group, whereby said mixture consists of (see figure2, paragraphs 51-53):

e1) exclusively said domestic financial investments if said available domestic weighting equals or exceeds said required industry weighting; otherwise (see figure2, paragraphs 51-53);

e2) domestic financial investments having a weighting substantially equal to said available domestic weighting and international financial investments having a weighting substantially equal to said required industry weighting minus said available domestic weighting (see figure2, paragraphs 51-53); and

f) repeating steps b) to e) until mixtures of financial investments for all of said industry based groups have been determined, thereby forming the weighting of said investment portfolio (see figure2, paragraphs 48-54).

Yip teaches a method and system to maximize the investment's return by rebalancing and fixing the weights of the investments based on clustering strategy (see paragraph 7). Yip displays the return difference between a specific region cluster (see figures 9-10, Examiner notes this as the domestic industry in Applicant's invention) and the World (Examiner notes this as the World industry in Applicant's invention). Hence, Yip discloses all limitations of Applicant's invention.

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22. **Regarding claim 2**, Yip teaches the domestic financial investments in step e1 have a weighting substantially equal to said required industry weighting (see Table II, 2nd and 4th columns).

23. **Regarding claim 3**, Yip teaches the industry based groups of step a) are consistent with the Global Industry Classification Standards (see paragraph 10 where it says MSCI World Index, Table II, 3rd and 5th columns. Examiner notes that the GIGS classification was introduced by MSCI per Applicant's specification, page 12).

24. **Regarding claim 4**, Yip teaches the industry-based groups are consistent with a plurality of industry groups as defined in the Global Industry Classification Standards (see paragraph 10, Table II).

25. **Regarding claim 5**, Yip teaches the required industry weighting determined in step c with reference to a selected industry based group is substantially equal to a global weight of said industry based group within a Morgan Stanley Capital International World Index (see paragraph 10, Table II).

26. **Regarding claim 6**, Yip teaches the required industry weighting determined in step c with reference to a selected industry based group is based upon an estimate of the future consumption from suppliers in said industry based group (see paragraph 35, "expected to grow". Examiner notes that future consumption reflects on expected to grow).

27. **Regarding claim 7**, Yip teaches that the domestic index is used to determine the available domestic weighting in step d (see Table II, "Annualized EW Cluster Return" vs. "EW Standard Deviation").

28. **Regarding claims 8, 9**, Yip teaches a figure from said domestic index is varied dependent upon pre-determined criteria prior to determining said available domestic weighting and a scaling factor dependent upon the pre-determined criteria (see paragraphs 14, 17).

29. **Regarding claim 10**, Yip teaches the pre-determined criteria includes appropriateness of exposure and optionally excessive exposure criteria (see paragraph 61).

30. **Regarding claims 11, 12**, Yip teaches the pre-determined criteria includes difficulty in trading equity investments associated with very small companies and companies with domestic equities (see paragraph 10, where it says "regional or global market index" and "without limitation").

31. **Regarding claims 13, 14, 15**, these claims relate to the place of a company associated with a domestic equity (see paragraph 78, Table I, Europe, Asia, North America).

32. **Regarding claims 16, 17, 18**, these claims relate to the maximum or minimum limits on either international or domestic expenditure, risk diversification, and market capitalization of financial investments (see paragraphs 61, 62).

33. **Regarding claims 19, 20**, these claims relate to an assessment of the value of an investment or a pre-selected group, and an assessment of the growth potential of an investment (see paragraph 35, 36, 38, 42, 44-46, 65, 75-77, figures 6, 7, 8).

34. **Regarding claim 21**, this claim relates to an assessment of various risks associated to an investment (see paragraphs 30, 61, 62)

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35. **Regarding claim 22**, this claim relates to various financial investments including one or more of the following: financial instruments; securities; equities; shares; futures; options; warrants; bonds; promissory notes; and other tradable financial products (see Table I, paragraph 78)

36. **Regarding claims 23-24**, these claims relate to a method of determining a mixture of financial investment within a pre-selected industry based group (see Abstract, paragraph 14, where it says rebalancing the investment within each cluster and between the clusters and also the rationale in claim 1).

37. **Regarding claims 25-27, 42**, these claims relate to a method for determining a weighting of a portfolio based on domestic and international benchmark or index.

These claims are similar to claims 1-22 and have same limitation. Hence, they are rejected under the rationale provided in claims 1-22.

Claim Rejections - 35 USC § 103

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

39. Claims 43-53 and 55-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Yip" in view of "Online Business Computer Applications" (On line Business Computer Applications, Second Edition by Alan L. Eliason) ("Alan").

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40. **Regarding claims 43-53 and 55-57**, these claims are the computer claims including computer system, medium and apparatus for determining weightings of an investment portfolio (see Yip, paragraphs 12, 13, 15, 16, 18).

41. In addition, Alan clearly shows that "most large business firms currently process the majority of their routine business transactions by computer." Hence, in view of Alan, it would have been obvious to one of ordinary skill in the art that these claims have similar limitation. The motivation to this is "computers are quite capable of preparing a wide variety of managerial reports and summaries and of storing large quantities of business informing." In other words, it makes the process easier, faster and more efficient by using a computer system. Therefore, claims 43-53 and 55-57 are rejected based on the rationale provided in claims 1-27.

42. **Regarding claims 58-63**, these claims are the method claims or apparatus claims, and are similar to the method claims 1-27 or the apparatus claims 43-53 and 55-57. Hence, they have the similar limitation and are rejected under the same rationale provided in claims 1-27 or claims 43-53 and 55-57.

43. **Regarding claims 64, 65**, these are the computer-implemented method claims for managing investments and similar to the method claims 1-27. Hence, they are rejected under the same rationale provided in claims 1-27 (also see Yip, paragraphs 12, 13, 15, 16, 18).

44. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the

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specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

45. Claims 1-27, 42-53, and 55-65 are rejected.

46. The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

47. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7364.

The examiner can normally be reached on M-F, 9-4 PM.

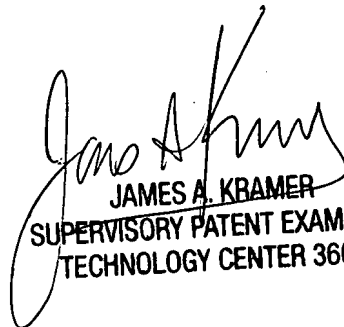
48. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

49. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT


JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
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